

S/N 10/763,930

Atty Dkt No. ~~Gr~~-303761(GM-0452PUS)Remarks

Claims 1-20 are pending in this application. Claim 12 was rejected under 35 USC §102(b) as being anticipated by Kaizu et al. (6,398,684). Claims 1-5, 7, 10-11, 13-17 and, 19-20 were rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. (6,425,841). Claims 6 and 18 were rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. in further view of Sakakibara et al. (4,347,763). Claim 8 was rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. in further view of Klecker et al. (6,244,965). Claim 9 was rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. in further view of Imai et al. (5,025,902). Claims 1, 4-6, 8-9, 11-12, and 16-18 are currently amended.

Claim Rejections - 35 U.S.C. § 102(b)

Claim 12 was rejected under 35 U.S.C. § 102(b) as being anticipated by Kaizu et al. For a rejection to be proper under 35 U.S.C. §102(b), every element and limitation found in the rejected claim must be found in the 102(b) reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, §14F.2d628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also, MPEP §2131.

The Examiner is correct when he states that Kaizu et al. disclose an automatic transmission with a plurality of planetary gear sets operatively connected between an input and output shaft. But the Examiner is incorrect when he states that Kaizu et al. disclose "a selectable reversible braking one-way clutch operative to brake rotation of one of said members of said planetary gear sets when the transmission is in reverse and first speed" as recited in Applicants' amended claim 12.

In rejection of claim 12, the Examiner called Applicants' attention to Figure 1 of Kaizu et al. with regard to "the combination of elements B1 and OW1" as anticipating the selectively reversible braking one-way clutch recited in Applicants' claim 12. However, the two components (B1 and OW1) do not anticipate the selectable reversible braking one-way clutch of claim 12, which eliminates the prior art low/reverse braking clutch and freewheeler, thereby

S/N 10/763,930

Atty Dkt No. GP-303761(GM-0452PUS)

improving transmission costs, packaging, and mass. (See paragraphs 0005 and 0006 of the present application). The selectable reversible braking one-way clutch has a plurality of functions which are *selectable*. Not only may the selectively reversible braking one-way clutch function to freewheel in one rotational direction but it also functions to brake in an opposite rotational direction thereby being usable in reverse and forward speeds while having fewer parts than the brake (B1) and one-way clutch (OW1) of Kaizu et al. Having "a selectable reversible braking one-way clutch operative to brake rotation of one of said members of said planetary gear sets when the transmission is in one of reverse and first speed, and disengaged in all other gear states" is not present in the Kaizu reference. Accordingly, the rejection of claim 12 is improper.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-5, 7, 10-11, 13-17 and 19-20 were rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. A proper rejection under 35 U.S.C. § 103(a) requires that the Examiner establish *prima facie* obviousness. As recited in the MPEP, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142. Three basic criteria must be met to establish *prima facie* obviousness. MPEP § 2143. First, there must be some suggestion or motivation to modify a reference or combine teachings. *Id.* Second, there must be reasonable expectation of success. *Id.* Third, the prior art reference or references must teach or suggest all the claim limitations. *Id.*

Similar to claim 12, amended claim 1 recites "a selectable braking one-way clutch operative to brake rotation of one of said members of said planetary gear sets when the transmission is in one of reverse and first speed --". Kaizu et al. do not present a selectable braking one-way clutch as discussed above. Nor do Haka et al. discuss "a selectable braking one-way clutch". Since neither reference teaches or suggests all of the claim limitations the rejection is improper and must fail.

Furthermore, the Examiner concedes that "Kaizu does not explicitly teach: wherein the transmission is characterized by the absence of a torque converter." The Examiner reaches to Haka et al. for this limitation. Haka et al. disclose a multi-speed power transmission

S/N 10/763,930

Atty Dkt No. GR-303761(GM-0452PUS)

which can be arranged with a conventional torque converter or a starting clutch. However, neither Haka et al. nor Kaizu et al. provide a "suggestion or motivation to modify -- or combine" the two references as required. The Examiner posits that improving the fuel efficiency of the multi-speed transmission serves as adequate motivation within the field. However, no proof is provided or suggested that would lead to the conclusion that replacing a torque converter on a transmission with a selectable braking one-way clutch (or starting clutch) would lead to increased fuel efficiency. The Examiner has not met his burden of establishing a prima facie case of obviousness; accordingly the rejection of claim 1 should fail. Claim 20 is believed to be allowable for at least the same reasons that claim 1 is allowable.

Claims 2-5, 7, 10-11 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable.

Claims 13-17 and 19 ultimately depend from claim 12 and are therefore allowable for at least the same reasons that claim 12 is allowable.

Regarding claim 13, the Examiner states that claim 13 is unpatentable over Kaizu et al. in view of Haka et al. Claim 13, includes the limitations of claim 12 and further recites, "wherein said first rotating input clutch is slipped for launching the vehicle in first speed --". Conversely, Kaizu et al. state, "For the selection of the first speed gear position in forward driving, the first clutch C1 is engaged as shown in Fig. 3A." Column 11, lines 18-19. Kaizu et al. make no mention of slipping the first rotating input clutch for launching the vehicle in first speed. The Examiner contends that the "first rotating input clutch (C1) is *inherently* slipped for launching the vehicle in first speed." (italics added for emphasis). However, no support is provided to demonstrate that Kaizu et al. intended for the input clutch C1 to slip instead of engaging as described therein. The two are not inherently the same. Column 10, line 21 of Kaizu states that "the input side [is] connected to a torque converter" (or input clutch) which slips for launch. Also, as shown in Figure 1 of Kaizu et al., R1 is directly connected to the input (IN) so that we can determine that C1 is not an input clutch. There is no reason to believe that C1 is "inherently" slipped for launch. It can be engaged while slipping occurs in the torque converter. Therefore, Kaizu et al. do not teach or suggest all of the claimed limitations of claim 13 and the obviousness rejection should fail accordingly. Additionally, the Examiner's similar assertion about Kaizu et al. disclosing, "said second rotating input clutch [that] is *inherently*

S/N 10/763,930

Atty Dkt No. GP-303761(GM-0452PUS)

slipped for launching the vehicle in reverse" is also inadequate for the reasons explained above. (italics added for emphasis).

Claims 6 and 18 were rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. in further view of Sakakibara et al. Amended claims 6 and 18 recite, "wherein said selectable braking one-way clutch is actuated hydraulically by a piston and valve." Sakakibara et al. disclose a one-way brake with improved endurance and increased wear resistance and stiffness in the cross-section of the end bearings of the one-way brake. Sakakibara et al. teach achieving these objectives by "increasing the area of that portion of an end bearing which is in sliding contact with an outer race or an inner race of a one-way brake --" not by the using "hydraulic control means" which are not even shown in Sakakibara and mention in passing as it pertains to all of the frictional clutches and brakes in Sakakibara. Column 3, lines 54-60 through Column 4, lines 1-4. No proof is provided or suggested that would lead to the conclusion that hydraulically actuating a selectable braking one-way clutch would lead to improved endurance of the one-way clutch as compared to any other means of controlling the clutch as the Examiner suggests. Accordingly, the Examiner has not met his burden of establishing a prima facie case of obviousness and the rejections of claims 6 and 18 should fail.

Claim 8 was rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. in further view of Klecker et al. Claim 8, however, ultimately depends from claim 1 and is therefore allowable for at least the same reasons that claim 1 is allowable.

Claim 9 was rejected under 35 USC §103(a) as being unpatentable over Kaizu et al. in view of Haka et al. in further view of Imai et al. Claim 9, however, ultimately depends from claim 1 and is therefore allowable for at least the same reasons that claim 1 is allowable.

CONCLUSION

This Amendment is believed to be fully responsive to the Office Action mailed March 02, 2005. The prior art made of record and not relied upon has been considered. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

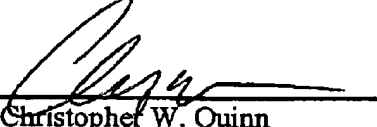
S/N 10/763,930

Atty Dkt No. GP-303761(GM-0452PUS)

Please charge any fees associated with this amendment to deposit account 07-0960.

Respectfully submitted,

SAMIE ET AL.

By 
Christopher W. Quinn
Reg. No. 38,274

Date: 6/2/05

QUINN LAW GROUP, PLLC
39555 Orchard Hill Place, Suite 520
Novi, Michigan 48375
Phone: 248-380-9300
Fax: 248-380-8968

On behalf of:

Kathryn Marra, Esq.
GENERAL MOTORS CORPORATION
Legal Staff Mail Code 482-C23-B21
P.O. Box 300
Detroit, Michigan 48265-3000

Auto-Reply Facsimile Transmission



TO: Fax Sender at 1 248 380 8968
Fax Information
Date Received: 6/2/2005 10:54:28 AM [Eastern Daylight Time]
Total Pages: 12 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page
=====>

JUN 01 2004 10:50AM QUINN LAW GROUP 1-248-380-8968 p.1

QUINN LAW GROUP, PLLC
3955 Orchard Hill Pl., Ste 510
Knox, Michigan 48379
Telephone: 248-380-8968 Fax: 248-380-8968

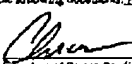
TO: UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT: 3681
NAME: David D. Lo
FAX NO.: 703-872-9106
SERIAL NO.: 10763,930
OUR FILE NO.: CP-303761/CPM0452PLS

This facsimile transmission contains privileged and confidential information intended for Group 3681 personnel only. If you are not the intended recipient, you are hereby notified that any dissemination or copying is strictly prohibited. If improperly received, please notify the sender whose name and number are listed in this document.

Certificate of Transmission under 37 C.F.R. § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on June 2, 2005 at facsimile number 703-872-9106.

Number of Sheets (including this cover): 12 which includes the following documents: Amendment Under 37 C.F.R. § 1.111


Signature of Person Sending Fax
Patricia Harding Fox
Typed or Printed Name of Person Sending Fax